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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/614,634	07/07/2003	James D. Coburn	98AB083-C	2199
63122	7590	11/28/2006	EXAMINER	
ROCKWELL AUTOMATION, INC./BF			LE, JOHN H	
1201 SOUTH SECOND STREET			ART UNIT	
MILWAUKEE, WI 53204			PAPER NUMBER	
			2863	

DATE MAILED: 11/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/614,634

Applicant(s)

COBURN ET AL.

Examiner

John H. Le

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 23 October 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-55 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 35-46 is/are allowed.
- 6) ☒ Claim(s) 1,2,5-11,14-34 and 47-55 is/are rejected.
- 7) ☒ Claim(s) 3 and 4 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

***Response to Amendment***

1. This office action is in response to applicant's amendment received on 10/23/2006.

Claims 53-55 have been amended.

The Terminal disclaimer have been submitted and approved.

***Claim Rejections - 35 USC § 101***

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 1-2, 5-11, 14-34, and 47-55 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The claims are directed to a judicial exception; as such, pursuant to the Interim Guidelines on Patent Eligible Subject Matter (MPEP 2106), the claims must have either physical transformation and/or a useful, concrete and tangible result. The claims fail to include transformation from one physical state to another. Although, the claims appear useful and concrete, there does not appear to be tangible result claimed.

Regarding claims 1-2, 5-11, and 14-22, claims appear to be drawn to an abstract idea (judicial exception), merely using the at least one identified CA instance to generate simulation information would not appear to be sufficient to constitute a tangible result, since the outcome of the using the at least one identified CA instance to generate simulation information step has not been used in a disclosed practical application nor made available in such a manner that it's usefulness in a disclosed practical application can be realized (e.g., in some instances, if it was "conveyed to someone" or "display" or

"stored by user" or "stored for later use by a user", that would establish a tangible result). Therefore, claim(s) 1-2, 5-11, and 14-21 appear(s) non-statutory.

Regarding claims 23-34 and 47-55, these claims are not directed to one of the 4 statutory categories of invention (See MPEP 2106.01), but are directed to nonstatutory functional descriptive material. Therefore, claim(s) 23-34 appear(s) non-statutory.

***Allowable Subject Matter***

4. Claims 35-46 allowed.

5. Claims 3-4 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

6. Claims 1, 23, and 47 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 101, set forth in this Office action.

The following is a statement of reasons for the indication of allowable subject matter:

Regarding claim 35, in combination with other limitations of the claims, none of the prior art of record teaches or suggests the combination of an apparatus to be used with a system including a simulator and a controller, the apparatus for generating code and simulation information for use by the controller and the simulator, respectively, the apparatus comprising: an editor for identifying at least one instance of at least one CA corresponding to at least one resource, wherein a processor running a program to perform the steps of: using the at least one identified CA to generate code for the corresponding at least one resource; and using the at least one identified CA instance

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to generate simulation information for the corresponding at least one resource. It is these limitations as they are claimed in the combination with other limitations of claim, which have not been found, taught or suggested in the prior art of record, that make these claims allowable over the prior art.

### ***Response to Arguments***

7. Applicant's arguments filed 10/23/2006 have been fully considered but they are not persuasive.

-Applicant argues that claims 1, 23, and 47 appear useful and concrete, and tangible result.

Examiner position is that claim 1 appears to be drawn to an abstract idea (judicial exception). As such, to be patent eligible, it needs to be directed to a practical application of the judicial exception. In order to determine whether the final step or result is tangible, applicant need to determine what the practical application is and then determine whether the claimed result is used in the practical application or made available in such a manner that the usefulness of the practical application can be realized. Regardless of what the practical application is, it does not appear the step of "using the at least one identified CA instance to generate simulation information" in claim 1 is tangible given that the information is not provided to the controller/simulator until claim 2. If the practical application can be realized by the generation of the simulator output, then it appears claim 3 would be tangible. Regarding claims 23 and 47, they do not appear to be directed to one of the 4 statutory categories. As such, claims 23 and 47 are rejected under 101. Further, please note that if it is directed to just

data, then putting it on a computer readable medium wouldn't put in a statutory category either since it's just be non-functional descriptive material.

- Applicant argues that claim 35 appear useful and concrete, and tangible result.

Examiner agrees since it includes structure. Therefore, claims 35-46 are allowed.

### ***Conclusion***

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

### ***Contact Information***

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John H. Le whose telephone number is 571 272 2275. The examiner can normally be reached on 9:00 - 5:30.

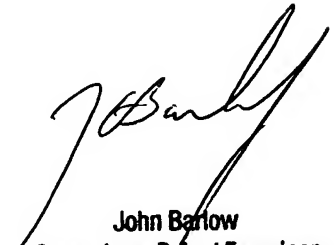
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John E. Barlow can be reached on 571 272 2269. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

John H. Le

Patent Examiner-Group 2863

November 21, 2006



John Barlow  
Supervisory Patent Examiner  
Technology Center 2800